

REMARKS

Upon entry of this amendment, Claims 8-20, 23, 25, and 29-34 constitute the pending claims. Claims 1-7, 21, 22, 24, 26-28 are cancelled without prejudice. Applicants reserve the right to prosecute claims of identical or similar scope in future continuation or divisional applications.

Applicants have also amended the claims to eliminate improper multiple dependency. As a result, new Claim 34 is added. New Claim 34 is supported by the original specification, including original Claim 18. No new matter is introduced.

Applicants hereby elect Group V, Claims 9-11, 14-15 (in part), 16, 17-20 (in part), 23 (in part), 25 (in part), 29-33 (in part), and new Claim 34 dependent on Group V claims, *with traverse*, on the following grounds.

First of all, Applicants submit that the reasoning of the Restriction Requirement is inconsistent with the requirement of PCT Rule 13.1. Specifically, the Restriction Requirement argues that there is no unity of invention, because “PCT rules provide for the examination of the first claimed product, the first claimed method of making said product and the first claimed method of using said product, not multiple processes.” Applicants respectfully disagree.

PCT Rule 13.1 provides: “[t]he international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (‘requirement of unity of invention’)” (emphasis added).

Therefore, contrary to what the Restriction Requirement asserts, PCT Rule 13.1 does provide the examination of multiple processes or multiple inventions, so long as the multiple processes are so linked as to form a single general inventive concept.

Secondly, regarding the “single general inventive concept,” PCT Rule 13.2 provides that “[w]here a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression ‘special technical features’ shall

mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.” *See also* 37 C.F.R. § 1.475(a).

Applicants submit that claims in Groups IV-VII fulfill the requirement of unity of invention, because claims in these groups share the same special technical features, as evidenced by the common method steps in the independent claims of Groups IV-VII. *See* Claims 8-13.

The Restriction Requirement fails to argue that the shared special technical feature, when considered as a whole, does not make over the prior art. In fact, the Restriction Requirement itself treats Groups IV-VII as a whole, and only argues that Groups IV-VII do not share the same special technical feature with Group I. *See* page 4, lines 11-16 of the Restriction Requirement.

Therefore, Applicants submit that the unity of invention requirement among Groups IV-VII is met. Reconsideration and withdrawal of the unity of invention rejection under PCT Rule 13.1 are respectfully requested.

The Restriction Requirement also requires Applicants to elect one of the ten listed species in Claim 33 as “heat shock protein homologues,” because these listed species allegedly lack unity of invention for not being “so linked as to form a single general inventive concept under PCT Rule 13.1.”

Applicants hereby elect, *for search purpose only*, species “proteins involved in the melanocortin peptidergic axis,” *with traverse*, on the following grounds. Applicants submit that the elected species read on all claims.

Applicants first note that “heat shock protein homologue” is itself a species in the Markush group of Claim 33. Thus Claim 33 does not intend to recite the ten listed species in the Restriction Requirement as species of the “heat shock protein homologue” genus, as the Restriction Requirement apparently interprets Claim 33.

Secondly, pursuant to MPEP 1850, Section II, “[u]nity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By ‘dependent’ claim is meant a claim which contains all the features of one or more other claims and contains a reference, preferably at

the beginning, to the other claim or claims and then states the additional features claimed (PCT Rule 6.4) ... If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention" (emphasis added).

Applicants submit that Claim 33 (in which the Markush group appears) is a dependent claim of Claim 32, which is a dependent claim of claim 15, which is a dependent claim of independent Claims 8-13. The Restriction Requirement improperly focuses on dependent Claim 33, rather than independent Claims 8-13 of the instant application. Furthermore, as argued above, the Restriction Requirement itself treats Groups IV-VII (which comprise independent Claims 8-13) as a whole, and never argues that the shared special technical feature among Groups IV-VII, when considered as a whole, does not make over the prior art. Thus if there is unity of invention among Groups IV-VII, the unity of invention rejection concerning the species listed in Claim 33 is improper.

Finally, PCT Rule 13.4 explicitly indicates that “[s]ubject to Rule 13.1, it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention.” Thus, even if there is no unity of invention among any two groups of Groups IV-VII, if Claim 15 is amended to depend on independent claims in the elected Group V, the unity of invention rejection with respect to the species in dependent Claim 33 should still be withdrawn.

Therefore, reconsideration and withdrawal of the species unity of invention rejection are respectfully requested.

The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition therefor and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**, under Order No. **BSWV-P01-007**. A duplicate copy of this paper is enclosed.

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Respectfully submitted,

By Yu Lu -

Yu Lu, Ph.D.

Registration No.: 50,306
ROPES & GRAY LLP
One International Place
Boston, Massachusetts 02110-2624
(617) 951-7000
(617) 951-7050 (Fax)
Attorneys/Agents For Applicant